REMARKS

Reconsideration of the above-identified application is respectfully requested.

In applicants' previous response, it was requested that the restriction be repeated and made final or be withdrawn. The Examiner has done neither. It is respectfully submitted that silence is ambiguous even though one might speculate that the examination of less than all the claims affirms the restriction. The restriction needs to be made final on the record and does not require a final Office Action for that purpose.

Claim 3 was rejected as indefinite. Although claim 3 clearly refers to step (c), and was therefore not indefinite, claim 3 has been amended to be explicit and somewhat repetitive.

Claims 1–3 were rejected as anticipated by Sullivan.

The system disclosed in FIG. 20 of the Sullivan patent is not a clocked system, as is applicants' system; i.e. the operation of the devices in not synchronized. The outputs of the comparators are coupled to the clock inputs of the flip-flops. If S1>S2>S3, then flip-flops 290 and 296 simultaneously produce pulses that are coupled through OR-gates 308 and 310, triggering monostable flip-flops 302 and 304. Simultaneous pulses are applied to counter 312. How this ambiguity is resolved is not disclosed.

"Summers" 146, 148, 150 are described as producing signals S1, S2, and S3 (column 11 lines 18–23). *"As shown in FIG. 11, each of the sum signals S1, S2 and S3 periodically rises and falls in intensity"* (column 11, lines 44–45). The cause of this rising and falling is not disclosed. Nor is it disclosed why the rising or falling is periodic.

It is axiomatic that the prior art must be enabling to be anticipatory; *In re Epstein*, 31 USPQ2d 1817 (Fed. Cir. 1994) and *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481 (Fed. Cir. 1997). For the foregoing reasons, it is respectfully submitted that the portion of the disclosure in the Sullivan patent relied on for rejection is not enabling.

Claim 1 recites "comparing the signals to each other and to at least one threshold." The signals S1, S2, and S3 are generated identically; see FIG. 8 of the Sullivan patent. There is no basis for identifying one as a "threshold", particularly when the patent itself does not disclose any of these signals as a threshold. To one of ordinary skill in the art, a threshold is a reference, not an input signal. Patent specifications are addressed to one of ordinary skill in the art. Although patent examiners are not ones of ordinary skill in the art, "Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum" MPEP §2106.

Claim 1 recites "converting a **plurality** of binary representations into a first count" [emphasis added]. During normal operation, the apparatus disclosed in the Sullivan patent operates on a single binary representation. A count of 1 from counter 312 clears the counter. There is no conversion of a plurality of binary representations into a count. It is, therefore, respectfully submitted that there is no anticipation.

In rejecting claim 1, the Examiner uses the same element (counter 312) to anticipate two steps in the recited method. This is improper. The steps are separate recitations that must be met separately.

In rejecting claim 1, the Examiner asserts that a counter inherently includes a comparator. A patent specification is directed to one of ordinary skill in the art. *In re Hayes Microcomputer Prods., Inc. Patent Litigation*, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992). One of ordinary skill in the art would not consider a counter a comparator; MPEP §2106.

By asserting inherency, the Examiner is asserting that a function necessarily exists. This is obviously not so because counters function quite nicely without comparators. For example, see the enclosed copy of page 125 from *Encyclopedia of Electronic Circuits*, Graf, Rudolf F. ed., TAB Books Division of McGraw–Hill, Inc., copyright 1991. Each "cell" includes only flip-flops and logic gates, yet the counter "freezes" as described. It is therefore respectfully submitted that the Examiner's rejection is based upon an error in fact.

The rejection is also based upon an error in law in that the existence of a result does not mean that a particular structure exists; *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917 (Fed. Cir. 2002).

In view of the foregoing amendment and remarks, it is respectfully submitted that claims 1–8 are in condition for allowance and a Notice to that effect is respectfully requested.

Respectfully submitted,

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